APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/457,669	12/09/1999	TETSURO MOTOYAMA	5244-0117-2X	7939

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EXAMINER
PRIETO, BEATRIZ

ART UNIT	PAPER NUMBER
2142	17

DATE MAILED: 03/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

Office Action Summary	Application No. 09/457,669	Applicant(s) MOTOYAMA, TETSURO
	Examiner B. Prieto	Art Unit 2142

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 January 2003* .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *52-124* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *52-124* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

   If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____ .

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

   a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)   4)☐ Interview Summary (PTO-413) Paper No(s). _____ .

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   5)☐ Notice of Informal Patent Application (PTO-152)

3)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *14* .   6)☐ Other: .

DETAILED ACTION

1.   This communication is in response to amendment filed 1/27/03, claims 52-124 remain pending and are hereby set forth for examination.

2.   Rejection under 35 U.S.C. 112 may be found in previous office action was obviated by above mentioned amendment, thereby it is hereby withdrawn.

3.   Admittance of prior art: Applicant has admitted on the record that the subject matter in relation to the amended limitation, specifically: electronic mail is transmitted using a protocol layer, which is at the application layer, therefore the techniques for implementation and/or enablement, are readily recognize by one ordinary skill in the art. This is taken as being available as prior art against the claims see MPEP § 2129, and 1.131. Therefore, the limitation's elements will be construed as encompassing any and every art-recognized hardware or combination of hardware and software technique for implementing the defined requisite functionalities.

4.   Quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action may be found in previous office action.

5.   Claims 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beilinski et. al. (Beilinski) U.S. Patent No. 5,123,089.

Regarding claim 52, Beilinski teaches a business office device (24, 26 and 28), which is connected to a monitoring device (12) that monitors the business office device response, the business office device comprising;

at least one memory (col 17/lines 41-47, storing sending/receiving information, col 3/lines 61-66, col 3/lines 7-12) for storing information to be communicated to the monitoring device communicated information, communicated information including sending an electronic mail message to the monitoring device, monitoring the business office device response (col 4/lines 12-47),

an network controller (interface) for bi-directionally communicating information (i.e. transmitting) and electronic mail (e-mail) message (col 6/lines 17-19) containing status information of the business office device to the monitoring device (col 4/lines 12-47, col 12/lines 42-50);

however the reference explicitly teach the e-mail interface is transmitted at the application layer;

It would have been obvious to one ordinary skilled in the art at the time the invention was made that to utilize Beilinski's teachings to execute claimed invention performing the same functions as claimed, and to further enable reference's e-mail interface for transmitting at the application layer an email message, as well known in the art, and for transmitting an e-mail message containing status information to the monitoring device, motivation would be to enable detect the status condition of a business office device such as a printer or modem, improve existing prior art by enabling a peripheral device to send information back to another business office device such as a computer, sending mail messages that indicate the status of the receiving office device or sending an error message, as taught by Beilinski.

6.   Claims 53-124 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beilinski et. al. (Beilinski) U.S. Patent No. 5,123,089 in view of Tarr et. al. (Tarr) U.S. Patent No. 5,184,179.

Regarding claim 53, however the above-mentioned prior art does not explicitly teach communicating with the monitoring device via a telephone system and a modem;

Tarr teaches a business office device (52) transmit status information to the monitoring device (54) (col 3/lines 33-40, col 5/lines 2-30) via telephone system and modem (14), a memory (504, 506) for storing status information (Fig. 6, step 316) (col 3/lines 61-col 4/line 3, col 4/lines 60-67) status information including a multiple portions (col 3/lines 40-49).

It would have been obvious to one ordinary skilled in the art at the time the invention was made to include means for the business office device transmits the status information to the monitoring device at a predetermined interval as taught by Tarr, into Beilinski system enabling the transmission of a first portion of status information, motivation would be improve existing monitoring system by implementing means for automatically notifying off-site parties at appropriate times of status of monitoring devices, as taught by Tarr.

Regarding claim 54, the email interface each can transmit one of the status information portions (Beilinski: col 6/lines 17-19 status information col 4/lines 12-47, col 12/lines 42-50) and direct connection-mode interface can transmit one of the status information portions (Tar: col 3/lines 40-49).

Regarding claim 55, wherein the business office device transmits the first portion of the status information to the monitoring device at a predetermined interval (Tarr: col 3/lines 33-40, col 5/lines 2-30).

Regarding claim 56, event-driven transmission (in response to the receipt of a status message containing an error message (Tarr: col 6/lines 55-col 7/lines 3).

Regarding claims 57-58, persistent memory for storing an assigned identification number (name) of the business office device (Tarr: col 5/lines 37-49, col 10/lines 61-67) and communication to monitoring device from the business office device enable monitoring device to identify transmitting business office device (Tarr: col 5/lines 37-40).

Regarding claim 59-60, persistent memory storing the telephone number (address) of the business office device and communicating said address to the monitoring device (Tarr: col 5/lines 30-40).

Regarding claims 61-62, status information is transmitted by the email interface (Beilinski: col 6/lines 17-19, col 4/lines 12-47, col 12/lines 42-50), transmitting status information as an email message, monitoring device polls business office device for status information (Tarr: col 6/lines 27-38).

Regarding claims 63-64, business office device is a printer (Tarr; col 2/lines 17-18), persistent memory storing option configuration (Tarr: col 9/lines 6-22).

Regarding claims 65-66, persistent memory stores a model and serial number (Tarr: col 5/lines 30-47).

Regarding claim 67, persistent memory stores characteristics of said business office device, which do not change over a life of said business office device (e.g. serial number discussed above).

Regarding claim 68, dynamic memory stores dynamic data (Tarr: col 3/lines 61-col 4/line 3).

Regarding claims 69, 71, 72, 73 and 75, dynamic memory stores an indication of a paper tray present in the business office device and indication of a status of paper in a paper tray present in the business office device (Tarr: col 3/lines 16-31, col 5/lines 60-col 6/line 2), an indication of consumable goods

(e.g. oil), amount of toner, number of prints in the business office device (Tarr: col 5/lines 60-col 6/line 2).

Regarding claims 70 and 74, storing in a dynamic memory an indication of a voltage used (Tarr: col 8/lines 56-67) and an indication of a sensitivity of photoreceptor in the business office device (Tarr: col 5/lines 60-col 3/line 2).

Regarding claim 76, substantially the same as claim 52 and further the business office device and monitoring device discussed above are comprised in a business system (Tarr: col 10/lines 5-18) and said monitoring device is monitoring from a remote location (Tarr: col 3/lines 10-40).

Regarding claim 77, as discussed on claims 52 and 76, the monitoring device monitors the business office device from a remote location (Tarr: col 3/line 16-40), storing within the system, status information of the business office device (Tarr: col 4/lines 60-col 5/line 8, diagnostic status data stored in RAM 28, col 7/lines 66-col 8/line 6, storing status information col 10/lines 53-66).

Regarding claim 78, establish a direct connection mode via terminal-based interface (i.e. interface linked to a telephone system from the monitored business office device to the monitoring device through a modem, Tarr: col 3/lines 33-40, col 5/lines 2-30 via telephone system and modem for transmitting status information portion across said link (Tarr: col 11/lines 17-26, maintenance status information, col 5/lines 3-13, col 14/line 63-col 15/line 2).

Regarding claim 79, first and second portion of status information are stored in the same (one) memory (Tarr: col 4/lines 60-col 5/line 8, diagnostic status data stored in RAM 28, col 7/lines 66-col 8/line 6, storing status information col 10/lines 53-66).

Regarding claims 80-100 are the monitoring method associated with the business office device discussed on claim, and substantially, same rationale is applicable.

Regarding claims 101-124, this claim is the computer program product, comprising: a computer storage medium and a computer program code mechanism embedded in the computer storage medium for monitoring a business office device, the computer program code mechanism comprising the computer code configured to perform the method discussed on claims 77-100, same rationale is applicable.

7.   Claims 52, 76, 77 and 101 may also be rejected under 35 U.S.C. 103(a) as being unpatentable over Beilinski et. al. (Beilinski) U.S. Patent No. 5,123,089 in Hirtle U.S. Patent No. 4,4750,114.

Regarding claim 52, Beilinski teaches a business office device (24, 26 and 28), which is connected to a monitoring device (12) that monitors the business office device response, the business office device comprising;

at least one memory (col 17/lines 41-47, storing sending/receiving information, col 3/lines 61-66, col 3/lines 7-12) for storing information to be communicated to the monitoring device communicated information, communicated information including sending an electronic mail message to the monitoring device, monitoring the business office device response (col 4/lines 12-47),

an network controller (interface) for bi-directionally communicating information (i.e. transmitting) and electronic mail (e-mail) message (col 6/lines 17-19) containing status information of the business office device to the monitoring device (col 4/lines 12-47, col 12/lines 42-50);

however the reference explicitly teach the electronic e-mail is transmitted using a protocol which is at the application layer.

Hirtle teaches a system/method related to the transmission of data, including where the electronic e-mail is transmitted using a protocol, which is at the application layer, (col 4/lines 8-18).

It would have been obvious to one ordinary skilled in the art at the time the invention was made to include means for transmitting an e-mail message as taught by Hirtle, motivation would be utilize standard enabled widely used technology, such as Internet technology based on the OSI model in which group of protocols, or rules for communicating are arranged in layer, each performing a specific data communication function, as well known in the art.

Regarding claim 76, substantially the same as claim 52 and further the business office device and monitoring device discussed above are comprised in a business system (Beilinski: col 6/lines 31-48) and said monitoring device is monitoring from a remote location (Beilinski: col 6/lines 31-48).

Regarding claim 77, as discussed on claims 52 and 76, the monitoring device monitors the business office device from a remote location (Beilinski: col 6/lines 31-48), storing within the system, status information of the business office device (Beilinski: col 17/lines 41-47, col 3/lines 61-66, col 3/lines 7-12, col 4/lines 12-47).

Regarding claims 101-124, this claim is the computer program product, comprising: a computer storage medium and a computer program code mechanism embedded in the computer storage medium for monitoring a business office device, the computer program code mechanism comprising the computer code configured to perform the method discussed on claims 77-100, same rationale is applicable.

8.   Claims 52, 76, 77 and 101 may also be rejected under 35 U.S.C. 103(a) as being unpatentable over Naugle U.S. Patent No. 5,715,393.

As exemplary in regards to claim 52, Naugle teaches substantial features of the invention as claimed, teaching a business office device (12) connected to a monitoring device (11) that monitors the business office device (col 2/lines 41-47);

        transmitting at an application layer (col 3/lines 23-25, 30-31), an email containing (first portion) status information to the monitoring device (11) (col 4/lines 4-9, col 5/lines 23-24, col 6/lines 34-36, 46-52);

        a memory for storing status information of the business office device (12) (col 4/lines 29-36, col 6/lines 50-59), although the all claimed functionalities are met by the prior art, prior art does not call the target computer (12) a "business office device" nor the monitoring computer (11) a "monitoring device".

        The differences of a nomenclature nature between the subject matter sought to be patented and the prior art, although not identically disclosed as set forth in section 102, are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art in view of the teachings of the prior art of record.

Response to arguments

9.   Applicant argues (a) prior art does not indicate that the computer is self monitoring, because computer (12) appears to have been considered a business office device and a monitoring device.

        In response to argument (a), that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (*i.e. a self monitoring device*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case prior art teaches where the business office device comprises: an network controller (interface) for bi-directionally communicating information (i.e.

transmitting) and electronic mail (e-mail) message (col 6/lines 17-19) containing status information of the business office device (24, 26, 28) to the monitoring device (12) (col 4/lines 12-47, col 12/lines 42-50).

10.   Applicant argues (b) prior art does not teach where the business office devices communicate with the monitoring device (12) using email protocol at an application layer.

In response to argument (b) that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (*the business office devices communicate with the monitoring device (12) using email protocol at an application layer*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In this case claim recites, a business office device comprising: an e-mail interface for transmitting, at an application layer, an e-mail containing a first portion of the status information to the monitoring device. Prior art teach an network controller (e-mail interface) for bi-directionally communicating information (i.e. transmitting) and electronic mail (e-mail) message (col 6/lines 17-19) containing status information of the business office device to the monitoring device (col 4/lines 12-47, col 12/lines 42-50).

11.   Applicant argues (c) that prior art does not teach where the business office devices (24, 26 and 28) communicate with the monitoring device (computer 12) using an e-mail protocol at an application layer, because according to applicant, the communication of an e-mail message is handled between the network node controllers and not between business office devices (24, 26, and 28).

In response to argument (c) that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (*an e-mail not handled by an email interfaces (network node controllers), but between business office devices (24, 26, and 28), nor where the business office device transmits an e-mail not an email interface (network controller), nor where the business device transmitting at an application layer, ...*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

12.   Applicant's arguments filed 01/27/03 have been fully considered but not rendered persuasive.

13.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office
action.   Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a).   Applicant is
reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for
reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the
event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory
action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee
pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,
however, will the statutory period for reply expire later than SIX MONTHS from the date of this final
action.

14.   Prosecution of this application is closed by means of this final office action § 1.113, applicant
may request continued examination of the application by filing a Request for Continued Examination of
under 37 CFR § 1.114 and providing the corresponding fee set forth in § 1.17(e) for the submission of,
but not limited to, new arguments, an information disclosure statement, an amendment to the written
description, claims, drawings, or new evidence in support of patentability. Or applicant whose claims
have been twice rejected, may appeal from the decision of the administrative patent judge to the Board of
Patent Appeals and Interferences under 35 U.S.C. §134.

Related U.S. Patents:

15.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure;
pertinence is presented in accordance with to MPEP§ 707.05. Copies of documents cited will be provided
as set forth in MPEP§ 707.05(a):

U.S. Patent No. 4,750,114 (June 1998): Hirtle teaches an email program operating at the 7th layer
called the application layer enables the transmissions of electronic mail messages (e-mail) (col 4/lines
8-18).

U.S. Patent No. 4,837,798 (June 1989): Cohen et. al. teaches architectural model underlying MHS
software application Messaging Handling System (MHS), the international standard for exchanging
electronic mail messages. The application layer services provided by MHS (col 5/lines 15-31)

U.S. Patent No. 5,471,503 (Nov. 1995): Altmaier et. al. teach electronic mail is transmitted using the protocol with is at the application layer (col 4/lines 59-65)   .

U.S. Patent No. 5,373,368 (Dec. 1994): Taniguro teaches office equipment includes computers (col 1/lines 8-24).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (703) 305-0750. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Mark R. Powell can be reached on (703) 305-9703. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-6606. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Any response to this final action should be mailed to:

> **Box AF**
> Commissioner of Patents and Trademarks
> Washington, D.C. 20231

or Faxed to:
> (703) 746-7238 for TC 2100 Official After-final communications; please mark "EXPEDITED PROCEDURE", and
> (703) 746-7239 for other TC 2100 Official communications.

or:
> (703) 465-7240 for Non-Official, Draft communications, status query, please label "PROPOSED" or "DRAFT".
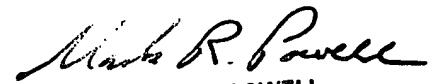
Or Telephone:
> (703) 306-5631 for TC 2100 Customer Service Office

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

B. Prieto
Patent Examiner
March 1, 2003

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